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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,515	10/20/2000	Silverbrook Kia	NPA046US	7941
24011	7590	01/06/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/693,515

Applicant(s)

KIA ET AL.

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 8/5/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 19 is/are allowed.
- 6) ☒ Claim(s) 4-18, 20-22 and 26-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/28/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 8/5/04.
- Amended to original filed specification to update the list of co-pending applications with US application numbers or granted patent numbers have been received and acknowledged on 8/5/04.
- Claims 1-24, 26-37 are pending in application; Claim 25 has been canceled.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-11, 15-17, 20-22, 26-30, 32-34, 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata et al (U.S. 6537324), and in view of Kasabach et al (U.S. 6628847).

Regarding claim 4, Tabata discloses a method of enabling graphic design by means of computer system (computer system, fig. 1), the method including the steps of:

- printing (printer 40, fig. 1, col. 5, lines 38-45) on demand, on a surface, a form (form, fig. 2) containing information relating to a graphic design activity, and at the same time as printing the information (a form containing graphics, texts, and coded data, figs. 2 and 5, col. 8, lines 31-67 to col. 9, lines 1-67 and col. 10, lines 12-30), printing on the surface coded data (coded data identifying linkage information of the form, fig. 2, col. 8, lines 32-50 to col. 9, lines 1-67 and col. 10, lines 12-30) indicative of at least one parameter of the graphic design activity (i.e. linkage information specifying a position of each of Dicons on the form, col. 9, lines 13-30 and 10, lines 12-30);

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- receiving (receiving coded data via a file server, fig. 3, 18-19), in a computer system, data from sensing device (sensing device 50 for sensing the coded data on the form, fig. 5) regarding said at least one parameter and the sensing device, when moved relative to the form, sensing the data regarding said at least one parameter using at least some of the coded data (coded data identifying linkage information of the form, fig. 2, col. 8, lines 32-50 and col. 10, lines 12-30)

However, Tabata fails to explicitly disclose a sensing device for sensing movement of the sensing device relative to the form and generating the data regarding its own movement relative to the form, and interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter.

Kasabach, in the same field of endeavor for sensing device, teaches a sensing device for sensing movement of the sensing device relative to the form and generating the data regarding its own movement relative to the form (position sensor for sensing the location of the sensing device relative to the form/paper, figs. 3-5, col. 3, lines 8-48), and interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter (position sensor for sensing the location of the sensing device relative to the form/paper, figs. 3-5, col. 3, lines 8-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of Kasabach because of a following reason: (1) to accurately determine the exact location of the sensing device relative to the form to prevent positional errors.

Therefore, it would have been obvious to combine Tabata with Kasabach to obtain the invention as specified in claim 4.

Regarding claims 5-8, Kasabach further teaches the method of claim 1 in which the parameter is an action parameter of the graphic design activity, the method including effecting, in the computer system, an operation in respect of the action parameter (writing and drawing, abstract and col. 3, lines 1-67 and font size, col. 7, lines 60-67).

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Regarding claims 9-11, Kasabach further teaches the method of claim 1 in which the parameter is a text parameter of the graphic design activity, the method including identifying, in the computer system, that a user has entered handwritten text data (handwritten text data, abstract and cols. 6-8) by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter.

Regarding claims 15-17, Kasabach further teaches the method of claim 1 in which the parameter is a drawing parameter (col. 6, lines 52-67 and col. 7, lines 15-67) of the graphic design activity, the method including identifying, in the computer system, that a user has entered hand-drawn graphic element (col. 6, lines 52-67 and col. 7, lines 15-67) by means of the sensing device (writing pen, fig. 5) and effecting, in the computer system, an operation associated with the drawing parameter.

Regarding claim 20, Tabata further teaches the method of claim 1 in which the sensing device contains an identification which imparts a unique identity (col. 3, lines 15-60) to the sensing device and identifies it as being associated with a particular user and in which the method includes monitoring, in the computer system, said identity.

Regarding claim 21, Kasabach further teaches the method of claim 1 including providing all required information relating to the graphic design activity (cols. 6-8) in the form to eliminate the need for a separate display device.

Regarding claim 22, Tabata further teaches the method of claim 1 in which the form is printed (printer 40, fig. 1) on multiple pages and in which the method includes binding the pages (method for binding pages are known in the art, i.e. using stapler, tape, clips, and etc).

Regarding claims 26-30, 32-34, 36-37 recite limitations that are similar and in the same scope of invention as to those in claims 4-11, 15-17, 20-22 above; therefore, claims 26-30, 32-

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34, 36-37 are rejected for the same rejection rationale/basis as described in claims 4-11, 15-17, 20-22.

3. Claims 12-14, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata and Kasabach as applied to claim 1 and/or 23 above, and further in view of Wolff et al (U.S. 6081261).

Regarding claims 12-14, and 31, the combinations of Tabata and Kasabach teach the method of handwritten recognition (Kasabach, col. 6-7), but does not explicitly teach the method in which the parameter is an authorization parameter of the graphic design activity, the method including identifying, in the computer system, that a user has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter.

Wolff, in the same field of endeavor for handwritten recognition and sensing device, teaches the method in which the parameter is an authorization parameter of the graphic design activity, the method including identifying, in the computer system, that a user has entered a handwritten signature (signature verification, col. 2, lines 58-62 and col. 8, lines 56-67) by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata and Kasabach as per teachings of Wolff because of a following reason: (1) to prevent forgers/unauthorized users accessing confidential materials/documents by using signature verification technique.

Therefore, it would have been obvious to combine Tabata and Kasabach with Wolff to obtain the invention as specified in claims 12-14, and 31.

4. Claims 18 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata and Kasabach as applied to claim 1 and/or 23 above, and further in view of Dymetman et al (U.S. 6330976).

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Regarding claims 18 and 35, the combinations of Tabata and Kasabach do not explicitly teach the method includes printing the coded data to be substantially invisible in the visible spectrum.

Dymetman, in the same field of endeavor for sensing device, teaches the method includes printing the coded data to be substantially invisible in the visible spectrum (col. 11, lines 45-67 to col. 12, lines 1-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata and Kasabach as per teachings of Dymetman because of a following reason: (1) to hide important coded data from being visible to an unauthorized users.

Therefore, it would have been obvious to combine Tabata and Kasabach with Dymetman to obtain the invention as specified in claims 18 and 35.

### ***Response to Arguments***

• Applicant's arguments, see page 12-13, filed on 8/5/04, with respect to claims 1 & 23 have been fully considered and are persuasive. The rejection of claims 1-3, 19, and 23-24 has been withdrawn. However, independent claims 4 and independent claim 26 fail to amend the allowable features/limitations include "sensing device for sensing its own movement relative to the form using at least some of the coded data"; therefore, independent claims 4, 26, and all of its preceding dependent claims are rejected for the same rationale/basis as discussed in previous office action, please see claim 4 above for more details.

### ***Allowable Subject Matter***

Claims 1-3, 19, 23-24 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior arts of record fail to teach and/or suggest the features: (●) receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device for sensing "its movement relative to the form using at least some of the coded data".

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*Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

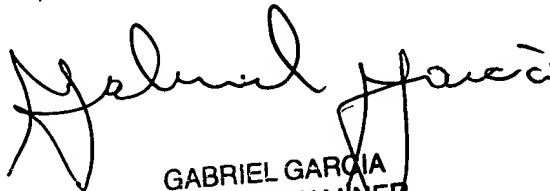
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

  
GABRIEL GARCIA  
PRIMARY EXAMINER